

January 25, 2010

The Honorable John Conyers
Chairman,
Committee on the Judiciary
House of Representatives
2138 Rayburn House Office Building
Washington, D.C. 20515-6216

The Honorable Lamar Smith
Ranking Member
Committee on the Judiciary
House of Representatives
2409 Rayburn House Office Building
Washington, D.C. 20515-4321

Re: Trademark Technical Improvements Act of 2010

Dear Chairman Conyers and Ranking Member Smith:

On behalf of the American Intellectual Property Law Association (AIPLA), I am writing to express support for the “Trademark Technical Improvements Act of 2010,” to make technical and conforming amendments to procedures involving implementation of the Madrid Protocol for the International Registration of Marks.

On balance, we view the bill as a highly desirable amendment to the Trademark Act, Title 15, United States Code, to bring trademark procedure under the Madrid Protocol into conformity with the procedures for regular U.S. applications and registrations.

AIPLA is a national bar association of approximately 16,000 members engaged in private and corporate practice, in government service, and in academia. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, and copyright law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property, and they have a keen interest in a strong and efficient intellectual property system and in competition.

Grace Period for Filing an Affidavit of Continued Use

AIPLA strongly supports the proposal to create a new Section 1141k(a)(3) of Title 15, to provide a 6-month grace period for filing an affidavit of continued use for a Madrid Protocol extension of protection. AIPLA considers this to be an important correction to conform the maintenance and renewal of Madrid Protocol extensions to the same schedule and procedure applied to regular U.S. registrations, for which a 6-month grace period already exists under the current Section 1058(c)(1).

AIPLA has supported making this amendment ever since the Madrid Protocol legislation was passed in 2003. It is particularly important to implement these changes before the first extensions affected by this legislation come due for maintenance filing in February 2010. AIPLA has received indications from the United States Patent and Trademark Office that it agrees with the need for the amendments, and we note that USPTO Director David Kappos recently devoted a page of his “Director’s Blog” to discussing the importance of this issue.

This amendment would put Madrid extensions on equal footing with regular registrations.

Correction of Deficient Affidavits

AIPLA also strongly supports the proposed amendments to Section 1141k(c) of the Title 15, to allow deficient affidavits to be corrected after the statutory time period. There already exists in the current Section 1058(c)(2) a provision for correcting deficient affidavits for regular U.S. registrations, and this proposal would simply create a corresponding provision for Madrid extensions of protection.

In accordance with its obligations under the Trademark Law Treaty (TLT), to which the United States is a party, the Trademark Act was amended in 1998 to allow a time for correction of deficient affidavits for regular U.S. registrations. Trademark Law Treaty Implementation Act of 1998 (TLTIA), Pub. L. 105-330, 112 Stat. 3064 (15 U.S.C. 1051). However, the proposed Madrid Protocol implementing legislation was pending at that time, and it was not updated prior to its enactment. Thus, this provision would correct an oversight in the original Madrid Protocol legislation that is both beneficial to applicants and required by US treaty obligations.

As above, this amendment would put Madrid extensions of protection on equal footing with regular registrations.

We thank you in advance for your consideration of these views.

Best regards,

A handwritten signature in black ink, appearing to read "Q Todd Dickinson", with a long horizontal flourish extending to the right.

Q Todd Dickinson
Executive Director